

Appl. No. 10/789,455

Amdt. dated December 5, 2005

Reply to Office Action of September 9, 2005

PATENT**BEST AVAILABLE COPY****REMARKS/ARGUMENTS**

Claims 1, 3-10, 12-18, 20-22 and 24-27 were pending in this application. No claims have been amended, added, or canceled. Hence, claims 1, 3-10, 12-18, 20-22 and 24-27 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1, 3-5, 7-10, 13, 15-18, 20-22 and 25-27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the cited portions of U.S. Patent Publication No. 2004/0069845 to Goldstein, *et al.* (hereinafter "Goldstein").

Claims 6, 12, 14 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldstein, in view of the cited portions of U.S. Patent Publication No. 2002/0174016 to Cuervo, *et al.* (hereinafter "Cuervo").

Claim Rejections Under 35 U.S.C. § 102(e)

The Applicants respectfully traverse the rejections of all claims since the cited reference does not teach all the claim limitations, either expressly or impliedly, as required for a proper rejection under 35 USC § 102(e). As an initial matter, Goldstein appears to teach a transaction card production system, not a method/system for ordering presentation instruments, as the Applicants claim. The system of Goldstein, while useful for filling orders, does not teach how the orders are placed. Hence, Goldstein does not appear to relate to the Applicant's claimed invention.

As to specific limitations, however, Goldstein fails to anticipate, for example, "sending one or more files that are executable by a computer of the purchaser to produce one or more corresponding display screens programmed to collect purchase information relating to the plurality of presentation instruments" as recited in claim 1. As Applicants are best able to understand the rejection of claim 1, the Office Action appears to state that the "one or more files" recited in claim 1 are "application forms to redeem personal information from the requestor/purchaser and means of personalizing the card with a unique identifier printed/embossed on the card, wherein the identifier may be the name of customer/recipient, or text or graphics and the like" (Office Action, ¶ 5). This supposedly-anticipating teaching is not in Goldstein and appears to originate with the Examiner, since nowhere does Goldstein teach

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"application forms," "applications," "forms," or anything else relating to "display screens programmed to collect purchase information relating to the plurality of presentation instruments" as recited in claim 1. Moreover, the Office Action makes no mention of how the application forms, even if taught by Goldstein, are "executable by a computer of the purchaser," which Goldstein also does not teach. Hence, Goldstein fails to anticipate claim 1 since Goldstein does not teach all the claim limitations, either explicitly or impliedly. Claim 1 is, therefore, believed to be allowable, at least for this reason.

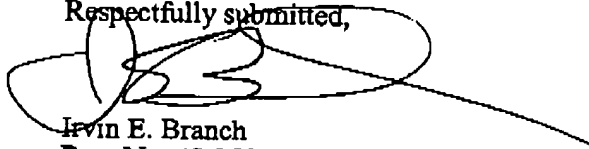
Claim 10, 13, and 21 include a similar limitation and are believed to be allowable, at least for similar reasons. The remaining claims depend from one of claims 1, 10, 13, and 21, and are believed to be allowable as dependent from allowable independent claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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